

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Application No. 09/888,298

Inventors: Ian E. Smith, et al.

Confirm. No.: 9531

Date Filed: June 22, 2001

Title: METHOD, SYSTEM AND ARTICLE OF MANUFACTURE
FOR ACCESSING COMPUTATIONAL RESOURCES
THROUGH ELECTRONIC MESSAGES

PATENT APPLICATION

Art Unit: 2157

Examiner: Emmanuel Coffy

Customer No. 23910

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 C.F.R. § 1.8

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Michelle McAnern Calavita

Michelle McAnern Calavita
Signature Date: July 14, 2005

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

These Remarks are in response to the Final Office Action mailed April 5, 2005 (hereafter, "Final Office Action"). Claims 1-23 were pending in the Application prior to the outstanding Final Office Action dated April 5, 2005. The Final Office Action rejected claims 1-23.

The Final Office Action, like the previous Office Action mailed October 4, 2004 (hereafter, "previous Office Action"), does not contain any grounds for rejection of claim 14, or any detailed reasons supporting rejection of claim 14. However, claim 14 is listed as rejected, along with all other claims, in the Office Action Summary for the Final Office Action. The additional limitations of claim 14, relating to a return address, are not contained in any other claim, and therefore are not

addressed anywhere in the Final Office Action. Applicants have repeatedly requested clarification of the basis for rejection of claim 14, but have not received a response.

One of the Final Office Action's principal references is ambiguous. In support of its rejection of independent claims 1 and 17, the Final Office Action makes reference (p.2, section 2, paragraph 2) to "Figs. And 4." Applicants are uncertain to what the Final Office Action intends to refer by this reference, and have requested clarification regarding the intended reference, but have not received a response.

Claims 1-3, 8, 9, 13, and 15-23 were rejected by the Final Office Action under 35 U.S.C. §102(e) as being anticipated by *Tilden, Jr.* *Tilden, Jr.* does not anticipate the invention as claimed. *Tilden, Jr.* teaches a data distribution system for deploying email using short email messages, which when opened call a large body of information from a server computer that includes a script program. The server computer and script program are necessarily under the control of the entity operating the invention. The stated principal application of the invention is the bulk sending of and subsequent user receipt verification of commercial electronic mail messages, commonly known as "spam." By contrast, the current claims describe an invention that allows a user to enhance the functionality of an email message by integrating the computation and functionality available through the Internet and elsewhere with a user's email message transmission.

Claims 1 and 17 were rejected by the Final Office Action as unpatentable over *Tilden, Jr.* Claims 1 and 17, unlike *Tilden, Jr.*, are not limited to making use of information on a user's website. Rather, claims 1 and 17 allow integration of functions and capabilities available on *any* website located *anywhere* in the world, with no limitation on the identity of the website's operator. Moreover, unlike *Tilden, Jr.*, claims 1 and 17 do not describe merely a method for increasing the size of email advertisements following their receipt and tracking their receipt. By contrast, claims 1 and 17 describe a robust method, article of manufacture, and apparatus for powerfully leveraging the virtually limitless capabilities of the Internet by permitting a user to avoid having to separately, manually travel to Internet sites to perform steps involved in composing an electronic mail message. The desired steps involving Internet access are automatically performed following receipt of the message according to the claims.

Claims 4-7 and 11-12 were rejected by the Final Office Action under 35 U.S.C. § 103(a) as being disclosed by *Tilden, Jr.* in view of Borenstein (WO 92/22033; hereafter, *Borenstein*). Claim 10 was rejected under 35 U.S.C. § 103(a) as being disclosed by *Tilden, Jr.* in view of Borenstein and further in view of Richard (U.S. Patent 6,728,711; hereafter, *Richard*).

The references cited in the Final Office Action, including *Tilden, Jr.* and Borenstein, either singly or in combination, fail to disclose all of the limitations of claims 4, 6, and 11-12. The references cited in the Final Office Action, including *Tilden, Jr.*, Borenstein, and *Richard*, either singly or in combination, also fail to disclose all of the limitations of claim 10.

With regard to claims 4 and 10, the Final Office Action concedes (p. 8, 2nd paragraph and p. 11, last paragraph) that *Tilden, Jr.* does not disclose determining an application provider. However, the Final Office Action states (p.8, 2nd paragraph and p. 11, last paragraph) that Borenstein discloses determining an application provider at “page 4, lines 1-6.” The cited section of Borenstein discloses that an active message can be received at one organizational center for asking a few questions to collect certain information, after which the active message sends itself off to the next link in the organizational chain. As examples, Borenstein discloses that expense vouchers, purchase orders, and insurance claims can be processed in this manner. Contrary to the suggestion of the Final Office Action, the cited section of Borenstein makes no disclosure regarding determining an application provider.

With regard to claim 6, the Final Office Action states (p. 9, 2nd paragraph) that *Tilden, Jr.* (col. 6, lines 18-25) teaches a script program which contains a command which performs a task in response to a user’s request. However, Applicants note that the Final Office Action concedes (pp. 3-4, section 5) that this section of *Tilden, Jr.* does not “accentuate” the disclosure such a script program. (Our Reply B filed April 26, 2005, at p. 11, last para.-p.12, 1st para., provides further reasons why these section cited in the earlier office action do not address the limitations of claim 6.) The Final Office Action concedes (pp. 3-4, section 5) that the previously cited section of *Tilden, Jr.* does not “accentuate” the disclosure such a script program. However, the Office Action states (pp. 3-4, section 5) that this disclosure is made in other sections of *Tilden, Jr.* (col. 2, lines 7-8, 13-19, 27-29, and 51-54). However, none of these four passages from *Tilden, Jr.* cited by the Final Office Action contain the disclosure for which they are cited. (See discussion in our Reply B filed April 26,

2005, page 9). While some of the passages mention a script program, contrary to the suggestion of the Final Office Action, none of them makes any disclosure regarding a script program that contains a command that performs a task *in response to a user's request*. For example, the second section of *Tilden, Jr.* cited by the Final Office Action (col. 2, lines 13-19) discloses means for storing a script program as a portion of a first source file; means for storing a *predefined* message as a second source file; means for including in the script program a command that displays the *predefined* message by retrieving the second source file; and means for directing the first source file to an email address of a user [emphasis added].

With regard to claims 11-12, the Final Office Action concedes (p. 10, 3rd paragraph and p. 10, last paragraph—p. 11, 1st paragraph) that *Tilden, Jr.* does not disclose alteration of the destination address. However, the Final Office Action states (p. 10, 3rd paragraph and p. 11, 1st paragraph) that Borenstein (page 4, lines 13-17) discloses alteration of the destination address. However, the cited section of Borenstein discloses that even more insidiously, one could create a mail based virus that could bring any computer network to its knees, simply by mailing out two copies of itself every time it is received by a recipient. Contrary to the suggestion of the Final Office Action, this section discloses nothing regarding alteration of the destination address.

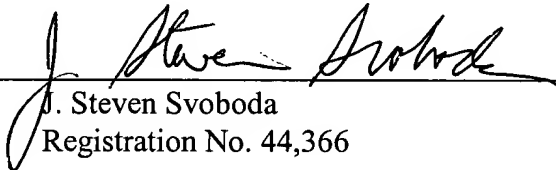
In light of the above, claims 1-23 are allowable.

Respectfully submitted,

Dated: _____

7/14/05

By: _____


J. Steven Svoboda
Registration No. 44,366

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Facsimile: (415) 362-2928
e-mail: jss@fdml.com